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(Serial No. 10/658,143)

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

IN RE PAUL LEW and JASON SCHIERS

Appeal from the United States Patent and Trademark Office Board of Patent
Appeals and Interferences in Appeal No. 2006-2136

REPLY BRIEF FOR APPELLANTS

PAUL LEW AND JASON SCHIERS

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I. ARGUMENT

Appellants respectfully request that this Court reverse the decision of the Board of Patent Appeals and Interferences (the "Board") to affirm the Examiner's rejection of Claim 19. The Solicitor for the United States Patent and Trademark Office (the "Solicitor") has not raised any meritorious arguments in his response brief. First, there is no evidence in the record, nor can the Solicitor provide any at this stage of the proceedings, to show that Applicants "mistakenly" disclosed roller bearings in their originally-filed application. Second, Applicants did not waive the Board's error in disregarding Applicants' disclosure of "roller bearings" in the originally-filed specification, particularly given the Examiner's failure to raise whether Applicants had disclosed roller bearings during prosecution of the application. Third, in affirming the § 112, first paragraph, rejection of Claim 19, the Board failed to consider Applicants' originally-filed specification as a whole, including the explicit disclosure of "roller bearings," and therefore, the Board committed clear error and should be reversed. Finally, the Board unreasonably ignored the interpretive guidance provided by Applicants' originally-filed disclosure in concluding that "curved members" impermissibly included inoperable embodiments, such as basketballs, chocolate candies, or computer mice.

A. The Solicitor's "mistake" argument is an improper new rationale that has no support in the record on appeal.

The Solicitor admits, as he must, that the original disclosure "describes figure 6B as 'showing the *roller* bearings in the hub inner section pockets' of ring 56." Br. at 22¹ (emphasis in original). Unable argue that Applicants disclosed "roller bearings," the Solicitor offers up a wholly unsupported argument that "the original specification only mistakenly uses the term 'roller bearings,' on two occasions, to mean *ball* bearings." Br. at 22. (emphasis in original). The Solicitor further states that "it is clear, from figures 6B and 6C that spherical *ball* bearings, rather than cylindrical roller bearings, are employed between the two sleeves." Br. at 22. (emphasis in original).

The Solicitor's argument fails for three reasons. First, the Solicitor raises these assertions for the first time in the Response Brief. Br. at 22. Neither the Examiner nor the Board ever asserted or suggested that Applicants made a "mistake" in explicitly disclosing the use of roller bearings. A4-10. Such a fact-specific argument cannot be raised for the first time on appeal; indeed, this Court has refused to allow the Solicitor to raise new rationales to support the Board's decisions. In re De Blauwe, 736 F.2d 699, 706 (Fed. Cir. 1984) (stating that the Solicitor cannot apply a new rationale to support a rejection in appeals from the

¹ Citations to the Appendix will be referred to as "A_," and citations to the Solicitor's brief will be referred to as "Br. at ____."

decision of the Board of Patent Appeals and Interferences). The Solicitor's argument should be rejected on these procedural grounds alone.

Even assuming *arguendo* that the Solicitor's argument had been properly raised before the Board, there are simply no facts in the record to support it. In re Gartside, 203 F.3d 1305, 1313 (Fed. Cir. 2000) (stating that this Court's review is limited to the record before the Board).

Based on the issuance of the parent application, it appears as though the Examiner in this case did not share the Solicitor's view that use of "roller bearings" was a mistake. Indeed, the Examiner in the present application was the same Examiner who allowed U.S. Patent No. 6,644,452 wherein "roller bearings" were explicitly disclosed in the specification. See U.S. Patent No. 6,644,452, Col. 4, ll. 28-34. Presumably, the Examiner, familiar from his work with the level of skill in the art, would have seen the "mistake," if there was one, and objected to it during prosecution; presumably, the Board would have noted the alleged "mistake" too. However, the record is devoid of any such factual support for counsel's argument. American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1359 (Fed. Cir. 1984) (the PTO is a "qualified government agency presumed to have properly done its job, which includes one or more examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only

valid patents”); In re Scarbrough, 500 F.2d 560, 566 (CCPA 1974) (stating “argument of counsel cannot take the place of evidence in the record”).

Finally, the record clearly shows that Applicants described, and depicted, a clutch assembly with “roller bearings.” A201. The Solicitor’s assertion that “it is clear from figures 6B and 6C that spherical *ball* bearings, rather than cylindrical roller bearings, are employed between the two sleeves” is plainly wrong. Br. at 22. (emphasis in original). There is no indication that the Solicitor possesses sufficient skill in the art to assert that spherical ball bearings, as opposed to cylindrical roller bearings, must be employed.² As such, the Solicitor’s argument that the Applicants “mistakenly” disclosed a hub using roller bearings to couple the inner and outer hubs is meritless. In fact, figures 6B and 6C support the Applicants’ explicit disclosure of a hub with roller bearings. A223-224. Figures 6B and 6C depict a cross-sectional view of the hub and the bearings. A223-224. A cross-sectional view of both a ball bearing and a roller bearing is depicted as a circle, which is the shape of the elements in figures 6B and 6C. A223-224. As such, upon review of Applicants’ original disclosure, one skilled in the art would recognize that Applicants did disclose a hub with roller bearings. In addition, one skilled in the art would clearly recognize that both a roller bearing and a ball

² Applicants observe that the Solicitor does not say that a roller bearing would not work; in fact, it would be clear to one skilled in the art that a cylindrically shaped roller bearing would work with the hub inner section and the hub outer section.

bearing would work in Applicants' wheel hub. The record plainly shows that Applicants explicitly stated and depicted an embodiment of the hub with roller bearings and an embodiment of the hub with ball bearings.³ Accordingly, Applicants *did* disclose the use of roller bearings in the clutch assembly.

- B. Because the Board did not address the Examiner's original § 112, First Paragraph rejection on grounds that the "specification did not disclose or provide clear definitions" and instead shifted to argument regarding the breadth of Applicants' originally-filed disclosure, Applicants did not waive argument that the originally-filed application disclosed "ball bearings," "roller bearings," and "ball surface."**

The Solicitor's "waiver" argument is meritless. The Examiner originally rejected Claim 19 under § 112, First Paragraph on grounds that the "specification did not disclose or provide clear definitions to support the claimed 'plurality of curved members'" (A78), not because of any defect with the originally-filed specification. Arguing that the specification inherently disclosed "curved members," Applicants properly addressed the Examiner's rejection regarding the need for "clear definitions."⁴ Rather than address the Examiner's original rejection regarding the disclosure of "clear definitions," the Board shifted to argument

³ As such, the Solicitor's argument that one skilled in the relevant art would read the Applicants' original disclosure as "requiring" ball bearings and therefore not disclosing the use of any alternatives is plainly not supported by the record.

⁴ By rule, Applicants' opening appeal brief to the Board was limited to the rejection that the Examiner had actually made. See, e.g., 37 C.F.R. § 41.37(c)(vi) (limiting appellants to a "concise statement" of each ground of rejection presented for review).

regarding the breadth of Applicants' originally-filed disclosure as the substantive basis for its decision to uphold the Examiner's § 112, First Paragraph rejection.⁵ In appealing the substantive basis of the Board's decision to this Court, Applicants did not waive anything, certainly not argument that the originally-filed application disclosed "ball bearings," "roller bearings," and the use of a "ball surface." Applicants never had a fair opportunity to address the matter during prosecution.

This case is much like In re Wright, 866 F.2d 422 (Fed. Cir. 1989). In that case, the Board sustained an examiner's new matter rejection, but in doing so, "added its own thinking in a somewhat different vein." Id. at 424. This Court did not reject the applicant's appeal in that case on procedural grounds such as waiver. Rather, this Court addressed the argument, considered the specification "as a whole," and reversed the Board's rejection under 35 U.S.C. § 112, First Paragraph. Id. at 424-25. Evidently, this Court implicitly recognized that no applicant could be expected to raise objections to the "added" thinking of the Board beforehand.

Generally, patent applicants are not sufficiently clairvoyant to predict the reasoning that the Board might employ *sua sponte* in any given case. Without a crystal ball, an applicant is simply unable to raise objections to the new thinking that the Board might employ in any particular case. If the Solicitor's waiver argument were to be applied, the Board's *sua sponte* reasoning, no matter how

⁵ The Board did not indicate that it was making a new rejection under 37 CFR § 1.196(b).

erroneous, would be insulated from this Court's review (because applicants would never be able to present their objections to the Board beforehand). Of course, this is nonsense, and the Solicitor's "waiver" argument simply misunderstands how and when arguments should be waived.

As this Court has recognized, an appellant's failure to raise an objection until a subsequent hearing constitutes waiver because the appellant's action precludes the board from having the opportunity to consider an alleged deficiency. In re Evanega, 829 F.2d 1110, 1113 (Fed. Cir. 1987) (citing United States v. L.A. Tucker Truck Lines, Inc., 344 U.S. 33 (1952)). However, waiver plainly does not apply when the Board raises an argument *sua sponte*. In such a case, "it cannot be said that the board did not have a chance to consider [the argument]." *Id.* at 1113.

In this case, the Examiner originally rejected Claim 19 under 35 U.S.C. § 112, first paragraph, based on the argument that Applicants' amended⁶ "specification did not disclose or provide clear definitions to support the claimed 'plurality of curved members.'" A78. The disclosure of "clear definitions" has little to do with whether the originally-filed specification disclosed "roller bearings." A78. Concern along these lines did not appear in the case until the Board explored the matter *sua sponte* and concluded that nothing other than "ball

⁶ Rather than fault the disclosure of the originally-filed specification, the Examiner faulted the disclosure of the "present specification" which had been previously amended on August 23, 2004 to present only Claim 19.

bearings” had been disclosed.

The originally-filed specification being supposedly limited to only “ball bearings” was the substantive basis for the Board’s decision that Applicants failed to comply with 35 U.S.C. § 112, first paragraph. As the substantive basis for the Board’s decision, the Board had an opportunity to consider the matter. Thus, the matter is properly subject to this Court’s review. The Solicitor’s waiver argument is meritless.

C. The Board’s failure to consider Applicants’ specification as a whole, including the use of “roller bearings,” was clearly erroneous and should be reversed.

Failing to consider Applicants’ specification as a whole, including the disclosure of “roller bearings,” the Board committed clear error in concluding that Claim 19 violated the written description requirement of 35 U.S.C. § 112, first paragraph. In the original disclosure, Applicants explicitly disclosed multiple embodiments (e.g. the use of a “roller bearing,” “ball bearing,” and a “ball surface”). A199, A201. The Board erroneously concluded that “nothing in the originally filed disclosure... indicated to an artisan that anything other than a ball bearing could be used.” A8. The Board simply failed to consider Applicants’ originally filed specification “as a whole.” In re Wright, 866 F.2d 422, 424-25 (Fed. Cir. 1989). That specification plainly disclosed “roller bearings,” as the

Solicitor acknowledges in his brief. Thus, the Board's error could not be more clear.

Ignoring the disclosure of "roller bearings," the Solicitor attempts to analogize this case to Gentry Gallery v. Berkline Corp., 134 F.3d 1473 (Fed. Cir. 1998). However, Gentry Gallery is clearly inapposite. That case concerned a sofa with a console provided with recliner controls. When the patentee sought to claim the sofa without limiting the location of the control, this Court concluded that a violation of § 112, first paragraph occurred because "the original disclosure clearly identifies the console as the only possible location for the controls." Id. at 1479. Putting to one side the disclosure of "roller bearings," the original disclosure in this case does not identify "ball bearings" as "the only possible" bearing that could be used.

The Solicitor also cites Tronzo v. Biomet, Inc., 156 F.3d 1154 (Fed. Cir. 1998). However, that case does not apply either. In Tronzo, this Court limited the patentee to the conical shape of a prosthesis "[b]ecause the written description only disclosed a conical shape for the prosthesis and characterized other shapes as 'prior art' and 'inferior' to a conical shape." Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 469 F.3d 1005, 1019 (Fed. Cir. 2006); Tronzo at 1158-60. In this case, Applicants disclosed the use of "roller bearings" in addition to "ball bearings" and distinguished the use of spring-biased pawls that had been employed

in prior art “ratchet-type designs.” A195. Applicants never characterized other bearings, such as roller bearings, as “inferior” to ball bearings as in Tronzo. The Solicitor’s citation to Tronzo is clearly misguided. DuPuy Spine, Inc. at 1020 (distinguishing Tronzo on the basis that “unlike the patent at issue in Tronzo, the written description in the ’ 678 patent does not label other shapes as ‘prior art’ and ‘inferior’”).

D. The Board unreasonably ignored the interpretive guidance of Applicants’ specification in concluding that Claim 19 violated 35 U.S.C. § 112, first paragraph.

The Board’s preoccupation with the scope of the claim term “curved member” (as well as the Solicitor’s) as being so broad as to include basketballs, chocolate candies, and computer mice, is both flawed and irrelevant. Argument directed at the scope of the phrase, “curved member,” rather than support for it, is “an irrelevant inquiry.” In re Wright, 866 F.2d 422, 425 (Fed. Cir. 1989). As this Court has instructed on a number of occasions, “[b]roadening a claim does not add new matter to the disclosure.” In re Rasmussen, 650 F.2d 1212, 1214 (CCPA 1981).

Furthermore, the mechanical field is a “fairly predictable field” (Bilstad v. Wakalopulous, 386 F.3d 1116, 1126 (Fed. Cir. 2004)), and the Examiner was well aware that Applicants were not trying to claim basketballs, M&M candies, or computer mice (See A30 (Examiner arguing that “curved members” encompasses

“bearings such as cylindrical bearings, tapered bearings, sleeve bearings, and roller bearings”)). As a result, it was unreasonable for the Board to disregard the interpretative guidance of the originally filed specification and dream up embodiments that rendered the claimed invention inoperable. In re Morris, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Notwithstanding the Board’s improper mental gymnastics in its construction of the claim term, “curved member,” Applicants did not impermissibly introduce new matter in violation of 35 U.S.C. § 112, first paragraph. The unusual decision below should be reversed.


II. CONCLUSION

For the foregoing reasons, this Court should reverse the Board's rejection of Claim 19 of the '143 Application under 35 U.S.C. § 112, first paragraph.

Antecedent

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CERTIFICATE OF SERVICE

I, Dana Andrew Alden, certify that an original and eleven (11) copies of the foregoing Reply Brief for Appellants, Paul Lew and Jason Schiers, were filed on this date, via first class mail, addressed to: Clerk of Court, United States Court of Appeals for the Federal Circuit, 717 Madison Place, N.W., Washington, D.C. 20439.

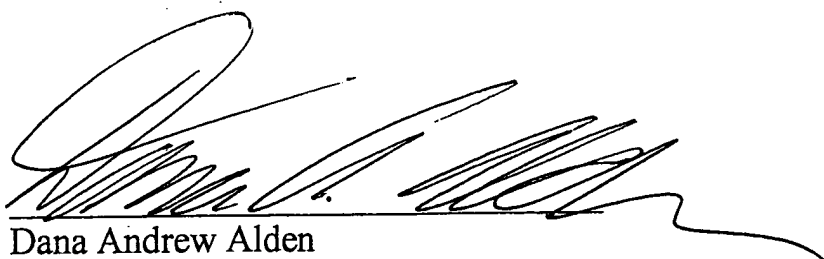
I, Dana Andrew Alden, certify that two true and correct copies of the foregoing Reply Brief for Appellants, Paul Lew and Jason Schiers, were served on this date, via first class mail, addressed to: Mr. Benjamin D. M. Wood, Office of the Solicitor, P.O. Box 15667, Arlington, Virginia 22215.

A handwritten signature in black ink, appearing to read 'Dana A. Alden', written over a horizontal line.

Dana Andrew Alden
July 5, 2007

CERTIFICATE OF COMPLIANCE WITH RULE 32(a)

I, Dana Andrew Alden, certify that the foregoing brief complies with the type-volume limitation set forth in Fed. R. App. P. 32(a)(7)(B). Specifically, this brief contains 2,884 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii), as determined by the word count feature of the word processing program used to create this brief. I further certify that the foregoing brief complies with the typeface requirements set forth in Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32 (a)(6). Specifically, this brief has been prepared using a proportionately spaced typeface using Microsoft Office Word 2003, in 14-point Times New Roman font.



Dana Andrew Alden